

Notice of Allowability

Application No.

09/577,294

Examiner

Lauren Q Wells

Applicant(s)

BLECKMANN ET AL.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to The Appeal Brief filed 1/22/04.
 2. ☒ The allowed claim(s) is/are 1,3,5,6 and 8-12 (renumbered as 1-9, respectively).
 3. ☐ The drawings filed on _____ are accepted by the Examiner.
 4. ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☒ All b) ☐ Some* c) ☐ None of the:
 1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).
- * Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

5. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
 6. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
 - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
7. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

- | | |
|---|---|
| 1. <input type="checkbox"/> Notice of References Cited (PTO-892) | 5. <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 2. <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 6. <input type="checkbox"/> Interview Summary (PTO-413),
Paper No./Mail Date _____ |
| 3. <input type="checkbox"/> Information Disclosure Statements (PTO-1449 or PTO/SB/08),
Paper No./Mail Date _____ | 7. <input checked="" type="checkbox"/> Examiner's Amendment/Comment |
| 4. <input type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit
of Biological Material | 8. <input checked="" type="checkbox"/> Examiner's Statement of Reasons for Allowance |
| | 9. <input type="checkbox"/> Other _____ |

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DETAILED ACTION

The Appeal Brief filed 1/22/04 has been received.

Examiner's Amendment

An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with Howard Lee on 5/3/04.

The application has been amended as follows:

In the Claims

Claim 1 has been substituted with amended claim 1 below:

1. A water-in-oil emulsion
 - (a) with a content of water and optionally water-soluble substances totalling at least 80% by weight and with a content of lipids, emulsifiers and lipophilic constituents totalling at most 20%, based in each case on the total weight of the emulsions,
 - (b) whose oil phase is chosen from the group of lipids or lipid mixtures, where the total polarity of the oil phase is between 20 and 30 mN/m, wherein the oil phase consists of at least 50% by weight, of at least one substance selected from the group consisting of (butyldecanol + hexyldecanol + hexyloctanol + butyloctanol), hexyldecanol, octyldodecanol, dicaprylyl ether, caprylic/capric triglycerides, octyl palmitate, isopropyl stearate, octyl octanoate, C₁₂₋₁₅-alkyl benzoates, cetylstearyl isonoanoate, butylene glycol caprylate/caproate, tricaprylin, octyldodecyl myristate, di-C₁₂₋₁₃-alkyl tartrates, caprylic/capric

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diglycerol succinate, octyl isostearate, stearyl heptanoate, cocoyl caprylate/caproate, isopropyl palmitate, cetylstearyl octanoate, and octyl stearate,

(c) comprising at least one interface-active substance, selected from the group consisting of alkylmethicone copolyols, alkylmethicone copolyols, and mixtures thereof,

(d) optionally, comprising one or more cationic polymers,

and having a viscosity at 25°C which is less than 5000 mPa•s.

Cancel claim 2.

Claim 3 has been substituted with amended claim 3 below:

3. The emulsion according to Claim 1, wherein the interface-active substances are selected from the group consisting of cetyltrimethicone copolyol, lauryltrimethicone copolyol and mixtures thereof.

Cancel claim 4.

Claims 5 and 6 have been substituted with amended claims 5 and 6 below:

5. The emulsion according to Claim 1, wherein cationic polymers are present in an amount of from 0.01 to 10%.

6. The emulsion according to Claim 1, wherein said cationic polymer(s) is/are selected from the group consisting of cationic cellulose derivatives, cationic starch, copolymers of diallylammonium salts and acrylamides, quaternized vinylpyrrolidone/vinylimidazole polymers, condensation products of polyglycols and amines, quaternized collagen polypeptides, quaternized wheat polypeptides, polyethyleneimine, cationic silicone polymers, copolymers of adipic acid with dimethylaminohydroxypropyldiethylenetriamine, copolymers of acrylic acid with dimethyldiallylammonium chloride, polyaminopolyamides, cationic chitin derivatives, cationic guar gum, quaternized ammonium salt polymers, and cationic biopolymers.

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Cancel claim 7.

Claims 8-12 have been substituted with amended claims 8-12 below:

8. The emulsion of claim 5, wherein the content of water and water-soluble constituents is between 75 and 80%.
9. The emulsion of claim 1, wherein the amount of water and water-soluble substances is greater than 85% by weight, based on the total weight of the emulsions.
10. The emulsion of claim 1, wherein the oil phase consists of at least 75% of said at least one substance.
11. The emulsion of claim 5, wherein said cationic polymers are present in an amount of from 0.25-1.25%.
12. The emulsion of claim 6, wherein said cationic polymers are selected from the group consisting of chitosan, having an average molecular weight of from 50,000 to 2,000,000 g/mol, determined by means of gel permeation chromatography, and a degree of acetylation of from 10 to 99%, determined by means of ¹H-NMR.

Reasons for Allowance

The following is an examiner's statement of reasons for allowance:

Claims 1, 3, 5-6 and 8-12 are allowable over the prior art, as the prior art neither teaches nor suggests the water-in-oil emulsion of instant claim 1.

The closest prior art is US 6,153,204, which teaches water-in-oil emulsions. However, '204 does not teach 1) the viscosity of such emulsions, let alone the viscosity recited in the instant claims; 2) lipids, emulsifiers and lipophilic constituents totaling at most 20% of the emulsion; 3) the total polarity of the oil phase between 20-30nM/m; 4) an emulsion containing at least 50% by weight of the oils recited in instant claim 1; and, 4) water and water-soluble

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substances totaling at least 80% of the emulsion. Furthermore, there is no motivation to increase the amount of the aqueous phase and, conversely to decrease the amount the oil phase of the emulsion of '204. While the prior art, US 5,616,746 and 2002/0064539, do teach aqueous phases of 80% and greater, the prior art aqueous phase emulsions are unique to the use of their specific compounds, and provide no motivation to teach the water-in-oil emulsions of '204 as having an aqueous phase of 80% or greater.

The above Examiner's amendment in combination with Applicant's arguments is persuasive to overcome the 35 USC 103 rejections in the previous Office Action.

The 35 USC 112 rejection over the phrase "lipids and lipophilic constituents" in the previous Office Action, is hereby withdrawn, as Applicant's arguments are persuasive and a search by the Examiner of the prior art (cosmetic emulsions) establishes that this is an art recognized term, wherein lipids are synonymous to oils and lipophilic constituents are synonymous to oil phase constituents.

The 35 USC 112 rejection over the phrase "derivative" in the previous Office Action, is hereby withdrawn, as Applicant's arguments are persuasive and a search by the Examiner of the prior art establishes that these terms "cationic cellulose derivative" and "cationic chitin derivative" are art recognized terms. Furthermore, regarding "cationic cellulose derivative", this phrase is defined on page 9 of the specification.

The abandonment of Applications 09/693161 and 09/428421 is sufficient to overcome the Double Patenting rejection over these claims in the previous Office Action.

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The provisional Double Patenting rejection over Application 09/328,727 is hereby withdrawn. Regarding the Double Patenting rejection over Application 09/328,727, the MPEP, Chapter 800 states that if the "provisional" double patenting rejection in one application is the only rejection remaining in that application, the examiner should then withdraw that rejection and permit the application to issue as a patent, thereby converting the "provisional" double patenting rejection in the other application(s) into a double patenting rejection at the time the one application issues as a patent. The instant Examiner has notified the Examiner of Application 09/328727, that this rejection is being withdrawn.

The Advisory Action mailed 11/19/03, withdrawn the 35 USC 112 rejection over the phrase "condensation products of polyglycols and amines".

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Conclusion

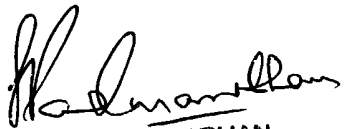
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lauren Q Wells whose telephone number is 571-272-0634. The examiner can normally be reached on M&R (5:30-4).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

lqw



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